

REMARKS

At the time of the Non-Final Office Action dated November 21, 2008, claims 1-10 were pending in this application. Claims 1-10 were rejected and claims 2, 4, and 8 were objected to because of informalities. Claims 11-30 were previously canceled. Claims 31-50 have been added and are substantially identical to the previously canceled claims 11-30.

CLAIMS 2, 4 AND 8 ARE OBJECTED TO BECAUSE OF INFORMALITIES

On page 2, paragraph 3 of the Non-Final Office Action, the Examiner asserted, “it is unclear whether the term ‘implementing an enrollment model’ is the same as the first occurrence in claim 1, line 5.” Although Applicants believe that there is no ambiguity with the “implementing an enrollment model”, the Applicants have amended claims 2, 4 and 8 to include the word, “the” before the phrase “implementing an enrollment model” as the Examiner has suggested. Accordingly, these amendments are not related to patentability

Applicants are unsure of why the Examiner asserted “it is unclear what is meant to the ‘authority to grant enrollment to one or more end user persons.’” The total phrase “administrators with the authority to grant enrollment to the one or more end user persons” is clear and unambiguous on its face. That is administrators will have the authority to grant or not grant enrollment into a collaborative computing community for an end user person. The factors that an administrator evaluates to determine whether “to grant enrollment” can be objective, personal, monetary or the like, and will depend on the

behavior model, e.g., administrative, profile, self-service, sponsored, etc., that is used in collaborative computing community

CLAIMS 1-10 ARE REJECTED UNDER 35 U.S.C. § 101

On pages 2-4, paragraphs 4 and 5 of the First Office Action, the Examiner asserted that the claimed invention, as recited in claims 1-10, fails to meet the requirements of 35 U.S.C. § 101. This rejection is respectfully traversed.

Claim 1

Independent claim 1 is directed to a “method for managing member enrollment in a collaborative computing community” (emphasis added). 35 U.S.C. § 101 states that:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Within In re Bilski, Appeal No. 2007-1130 (Fed. Cir. 2008), the Federal Circuit “[clarified] the standards applicable in determining whether a claimed method constitutes a statutory ‘process’ under § 101.” The Federal Circuit framed the issue as to whether a claimed method constitutes a statutory process as follows:

The true issue before us then is whether Applicants are seeking to claim a fundamental principle (such as an abstract idea) or a mental process. And the underlying legal question thus presented is what test or set of criteria governs the determination by the Patent and Trademark Office (“PTO”) or courts as to whether a claim to a process is patentable under § 101 or, conversely, is drawn to unpatentable subject matter because it claims only a fundamental principle.

At the outset, Applicants note that the Examiner has neither alleged nor provided any substantial evidence to support a finding that claim 1 attempts to claim either a fundamental principle or a mental process. Therefore, the Examiner's has failed to set forth a prima facie case under 35 U.S.C. § 101.

On page 3 of the Non-Final Office Action, the Examiner asserts "an administer may manually organize or enroll members for the so-called collaborative computing community without necessarily engaging a computer," (emphasis original). Applicants respectfully disagree with this assertion. Claim 1 is clearly not a mental process since neither the creation of a service or the deployment of a service is a mental process. The only other issue that need be addressed is whether or not "[Applicants'] claim recites a fundamental principle and, if so, whether it would pre-empt substantially all uses of that fundamental principle if allowed." Biliski at __. The Examiner has not alleged that claim 1 is directed to a fundamental principle or even characterized what that "fundamental principle" might be. Thus, there is no need to determine if claim 1 preempts substantially all uses of the (unidentified) fundamental principle.

However, should the Examiner put forth substantial evidence to establish that claim 1 recites a fundamental principle, the Federal Circuit within In re Bilski looked to the following test to determine whether a process claim is narrowly tailored so as to not preempt all uses of the fundamental principle:

A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.

Thus, the machine-or-transformation test is a two-branched inquiry – a method claim satisfies 35 U.S.C. § 101 by being tied to a particular machine or transforming an article. Gottschalk v. Benson, 409 U.S. 63, 70 (1972).

Turning to the second branch, claim 1 transforms a particular article into a different state or thing. As recited in claim 1, services that manage member enrollment in a collaborative computing community are created. The act of the creation is a transformation, and the services are the article. Therefore, claim 1 is directed to statutory subject matter under 35 U.S.C. § 101 since claim 1 transform a particular article into a different state or thing.

**THE REJECTION OF CLAIMS 1-9 UNDER 35 U.S.C. § 102 FOR ANTICIPATION
BASED UPON U.S. PATENT NO. 6,480,885 TO OLIVIER, (HEREINAFTER OLIVIER)**

On pages 4-7, of the Non-Final Office Action, the Examiner asserted that Olivier discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single reference.¹ Moreover, the anticipating prior art reference must describe the recited invention with sufficient clarity and detail to establish that the claimed limitations

¹ In re Rijkckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984).

existed in the prior art and that such existence would be recognized by one having ordinary skill in the art.²

“Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims. ... The second step in the analyses requires a comparison of the properly construed claim to the prior art.”³ During patent examination, the pending claims must be “given their broadest reasonable interpretation consistent with the specification,”⁴ and the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach.⁵ Therefore, the Examiner must (i) identify the individual elements of the claims and properly construe these individual elements,⁶ and (ii) identify corresponding elements disclosed in the allegedly anticipating reference and compare these allegedly corresponding elements to the individual elements of the claims.⁷ This burden has not been met. In this regard, the Examiner’s rejection under 35 U.S.C. § 102 also fails to comply with 37 C.F.R. § 1.104(c).⁸

² See *In re Spada*, 911 F.2d 705, 708, 15 USPQ 1655, 1657 (Fed. Cir. 1990); *Diversitech Corp. v. Century Steps Inc.*, 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).

³ *Medichem, S.A. v. Rolabo, S.L.*, 353 F.3d 928, 933 (Fed. Cir. 2003) (internal citations omitted).

⁴ *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

⁵ *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

⁶ See also, *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, “what is the invention claimed?” since “[c]laim interpretation, . . . will normally control the remainder of the decisional process”); see *Gechter v. Davidson*, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).

⁷ *Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

⁸ 37 C.F.R. § 1.104(c) provides:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

In Applicants' response to the First Office Action, the Applicants stated that Applicants' claims all refer explicitly to a "collaborative computing community".

Nowhere in Olivier is a collaborative computing community disclosed. Exemplary claim 1 recites as follows:

1. A method for managing member enrollment in a collaborative computing community, the method comprising:
 - identifying one or more end user persons for enrollment in the collaborative computing community;
 - implementing an enrollment model to determine whether to enroll the one or more identified end user persons as members in the community; and
 - updating community membership to enroll the one or more end user persons based on the implemented enrollment model.

In paragraph 8 of the Non-Final Office Action, the Examiner expressly stated that the "identifying one or more end user persons for enrollment in the collaborative computing community" is disclosed in the Abstract of Olivier. A careful examination of the Abstract of Olivier fails to find any mention of a "identifying one or more end user persons for enrollment in the collaborative computing community". Instead, the Abstract of Olivier is limited to describing a method for "enabling users to exchange group electronic mail by establishing individual profiles and criteria (see lines 1-3 of the Abstract of Olivier).

The Abstract of Olivier is a far cry from the "collaborative computing community" of the Applicants. In particular, the Applicants have defined the "collaborative computing community" as being "defined by (1) a particular context, i.e., the objective of the environment, (2) membership, i.e., the participants in the environment, (3) a set of roles for the members, and (4) resources and tools which can be

accessed by the membership in furtherance of the objective of the environment" (See paragraph [0003] of Applicants' specification).

In paragraph 18 of the Final Office Action dated April 30, 2008, the Examiner stated that:

...Olivier teaches that a member may volunteer to be a moderator functioning as a human filter for inappropriate messages, scanning for "spam", and other messages that shouldn't be sent to subscribers. At col. 17 lines 7-20, a special role called "approval user" is described in forming a professional jazz team...For example, spam filtering and language translation tools are described at col. 17, lines 21-39. Servers functioning at different stages of community activities are depicted in Fig. 7 and its related passages. All of which can be accessed by the membership in furtherance of the objective of the environment.

For ease of reference, the Examiner's cited passages are reproduced below:

An example is a professional sub-group of a jazz mailing list. Subscribers checking the "Professional" experience checkbox would need to be approved before admittance. In this case, the subscriber is told that his subscription will need to be approved, and his subscription record is stored in a pending subscriptions table. The approval user is emailed with a request for approval. If the approval does not take place within 14 days, the subscriber is automatically rejected by the system. (emphasis added)

And;

Another additional feature is to install a process near the beginning of the email distribution process for eliminating unwanted commercial email ("spam"). Such systems are commercially available and are configured independently of this invention. The email server process would allow the service provider to configure it to incorporate a spam elimination process at the appropriate step in the process. (emphasis added)

And:

Another alternative embodiment to FIG. 5B is depicted in FIG. 7. In this embodiment, the matching is done through multiple computers operating as a distributed system. All communication between computers is through a standard means such as CORBA. A Match Dispatch Server computer distributes the matching process across a cluster of Match Servers. Each match server handles part of the total number of subscriptions in the system. Each match server keeps its own cached copy of the database data for high-speed access during the matching process. To conduct a match, a client sends a match request to the Match Dispatch Server ("dispatcher"). The dispatcher has a lookup table describing which Match Servers are needed to compute a particular match. The dispatcher returns a list of Match Servers to use in completing a dynamic match. The client then requests those match servers to perform partial matches, and the results are combined for the final answer. The lookup table is centralized on the dispatcher system. Data changes (e.g., from a user tuning his community settings on the web site) will first be stored in an SQL database, and then updates distributed to appropriate server(s). Although FIG. 7 only shows a single dispatcher, multiple redundant dispatchers may be used.

How these passages identically disclose the claimed invention is entirely unclear. For example, the cited passage of Olivier is specifically directed to a “mailing list” from which a subscriber can receive electric mail, which falls short of a “collaborative computing environment” as recited in claim 1. Moreover, the cited passage is silent as to what “enrollment model” is to be implemented. In addition, the Examiner’s reliance on col 17, lines 21-29 to teach “various resources and tools” made available for use in the electronic mail system of Olivier. In fact, Olivier teaches in the cited passage that the “email server process would allow the service provider to configure it to incorporate a spam elimination process.” (emphasis added). There is no indication that an individual user or subscriber would deploy or implement the “spam filter” selectively.

The Examiner’s reliance on the “language translation tool” is also misplaced. The cited passage of Olivier is silence as to any collaborative endeavor of different users or subscribers with respect to the language translation tool. Specifically, the “user specifies the language of choice as part of the subscription process” (col. 17, lines 30-31 of Olivier). In other words, when the user initially subscribes to the Olivier email distribution process, that user selects a language that the user prefers to receive email messages. Accordingly, the cited passages by the Examiner fail to support the elements and/or limitations that the Examiner has relied on them to teach or disclose. Therefore, the Examiner has failed to establish that Olivier identically discloses the claimed invention, as recited in claim 1, within the meaning of 35 U.S.C. § 102.

Claim 2

At paragraph 6 of the Office Action, the Examiner erroneously asserts that Fig. 8; col.10, lines 43-59 of Olivier discloses “wherein the implementing an enrollment model includes designating one or more community members as administrators with the authority to grant enrollment to the one or more end user persons,” as recited in claim 2. For convenience a verbatim reproduction of the recited portion of Olivier is provided herein:

To summarize by way of example, suppose a user decides to try out a mailing list that uses this invention. He signs up at the service provider's web site, selecting a mailing list about the topic of financial investments. He specifies (user profile acceptance criteria data) he would like to interact with other men of age 40-50 who live within three miles of him and do not have children. Using an optional feature, he selects the subtopics (message criteria) related to internet stocks, junk bonds, and international mutual funds. The system responds with a preview of 38 matching subscribers and five messages per week. He wants more people to interact with, so he increases his age criteria to include men between 35-55. He also increases his distance criteria to five miles. Now the system matches him with 68 people and 12 messages per week, and he accepts the setup. The system stores that subscription; soon he will begin interacting with his matched subscribers. (emphasized added).

Notably, there is no mention of “wherein the implementing an enrollment model includes designating one or more community members as administrators with the authority to grant enrollment to the one or more end user persons”. In contrast, Fig. 8; col.10, lines 43-59 of Olivier teaches that a list of potential users that matched that users inquiry, but the passage is silence to the “authority to grant enrollment to the one or more end user persons”. Accordingly, the Examiner has failed to establish that the applied art teaches all of the claimed features. Specifically, the Examiner’s analysis ignores the active step of “granting enrollment to the one or more end user persons” as claimed.

Accordingly, the Examiner has failed to designate the teaching in Olivier being relied upon to state the rejection. In this regard, the Examiner’s rejection under 35 U.S.C.

§ 102 fails to comply with 37 C.F.R. § 1.104(C). Thus, Olivier fails as a reference to anticipate the claimed invention.

Claims 3-10

Claims 3-10 all depend from Claims 1 and 2, either directly or indirectly and for the reasons given with respect to Claims 1 and 2, Claims 3-10 are not anticipated by Olivier.

Applicants have made every effort to present claims, which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 12-2158, and please credit any excess fees to such deposit account.

Respectfully submitted,

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